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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,796	09/18/2001	Ed O. Schlotzhauer	10010804-1	1044

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EXAMINER
WEST, JEFFREY R

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/955,796	SCHLOTZHAUER ET AL.	
	Examiner	Art Unit	
	Jeffrey R. West	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication/
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2001* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to because in Figure 3A, the register_variation function includes the module "Algorithm_Modification" while the corresponding description in the specification defines the register_variation function as including a "Process_Modification" module (page 10, lines 15-17). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The use of the trademarks "JAVA" (Sun Microsystems) and "CORBA" (Object Management Group) have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claims 25 and 36 are objected to because of the following informalities:

Claim 25 is objected to because of incorrect dependency. Currently, claim 25 is dependent on claim 26. Since this is not valid dependency, for the examination of the application, claim 25 is assumed to be dependent on claim 24.

In claim 36, "wherein said interface determined" should be ---wherein said interface is determined----.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

5. Claims 2-8, 33-35, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation, "an interface servicing element that services an interface realized by the measurement process." In this limitation, the term "realized" is considered to be vague and indefinite because it fails to provide a specific relationship between software devices. It is suggested that application change "realized" to ---recognized--- or a similar, more definite, term.

Claims 4 and 33 are rejected under 35 U.S.C. 112, second paragraph, because of the unclear language, "wherein said predetermined protocol is specified at a binary level". In this passage it is unclear what it means for a protocol to be

"specified at a binary level" since protocol is generally defined as a rules for binary communication.

Claims 8 and 37 contain the trademark/trade name "JAVA". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a programming language and, accordingly, the identification/description is indefinite.

Claims 3, 5-7, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, because they incorporate the lack of clarity present in their respective parent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 7-9, 14-33, and 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,385,552 to Snyder.

Snyder discloses a method for collecting and controlling test measurements using programmed instructions comprising determining the variation to a measurement process (i.e. determining a test of interest to perform and relating the test of interest to test variables and independent variables and varying the test variables during the process) (column 3, lines 50-58 and column 16, lines 5-14), providing a process modification software module including a user defined function for causing the variation and associating the user-defined function with the variation function wherein control is passed to the user-defined function when a variation point in the computer program is reached (i.e. a menu subroutine is executed when a variation point of the program is reached and, upon the selection of a user-defined function/procedure from the menu, control is passed from the menu subroutine to the selected procedure/passed into the measurement process) (column 26, lines 33-67).

Snyder discloses that the function calls used in the process are operable to invoke interfaces and to pass parameters to the variation functions including keywords (column 26, lines 62-67) or measurement data (column 29, lines 49-53) as well as operable to receive/retrieve parameters back from the variation function including control parameters indicative of the selected instructions provided (column

26, lines 49-52). Snyder also discloses an interface servicing element (i.e. menu interpreter) that services an interface recognized by the measurement process (i.e. the menu interpreter is called upon when the variation point is reached in order to execute the menu subroutine for obtaining the user defined function) (column 23, line 57 to column 24, line 3), wherein the interface is selected by the user (column 26, lines 16-44) and operates in accordance with a predetermined binary protocol (column 27, lines 20-24).

With respect to claim 8, Snyder also discloses providing the process modification software modules as Active X (i.e. Component Object Module) Dynamically Linked Libraries (column 20, lines 12-23).

With respect to claims 14-18, Snyder discloses that the variation in the measurement process modifies either string or numeric data (column 14, lines 10-11) as well as provides a menu of selectable alternatives for user-modification of control parameters, test device configuration, and device input signals (column 3, lines 53-55, column 5, lines 3-6 and 50-59, and column 17, lines 31-38) and since the parameters are used for control of the device inputs and configuration, these parameters are considered to be digital control codes.

With respect to claims 19 and 20, Snyder also discloses that in addition to the aforementioned user-defined function called by the variation point that calls to the menu subroutine, further user-defined security and test set functions are also called to when associated variation points for the security and test set subroutines are reached (column 23, lines 57-67).

With respect to claim 9, Snyder also discloses executing both the measurement process and the process modification in the same computer space (i.e. computer "200") (column 3, lines 49-58 and Figure 1).

With respect to claim 39, since the function calls disclosed by Snyder are in the instruction code, operable to control the measurement process at a variation point in the code, and allows corresponding user input to modify the measurement process, it is considered inherent that the designer of the instruction program has anticipated that the user may want to interact with or modify the measurement process because the designer of the code would have eliminated the possibility of user intervention and would not have provided user prompts if such interaction was not desired.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

9. Claim 5, 6, 10-13, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of U.S. Patent Application Publication No. 2002/0026514 to Ellis et al.

As noted above, the invention of Snyder teaches many of the features of the claimed invention including an automatic testing system comprising a user interface to allow the user to control the testing a device wherein the interface operates in

accordance with a predetermined binary protocol. Snyder does not teach, however, specifying that the predetermined protocol be a Simple Object Access Protocol or Common Object Request Broker Architecture or that the measurement process and the modification software are located in separate remote computers that communicate over a network.

Ellis teaches automated tool management in a multi-protocol environment comprising measuring/polling software located on a server computer system with corresponding processor and memory (0025, lines 1-13) and user process control software (0007, lines 11-16) located on a separate remote computer (0023, lines 13-18), wherein the process control software and the monitoring/polling software communicate over a network using predetermined protocol including Common Object Request Broker Architecture, and Simple Object Access Protocol (0007, lines 1-11).

It would have been obvious to one having ordinary skill in the art to modify the invention of Snyder to include specifying that the predetermined protocol be a Simple Object Access Protocol or a Common Object Request Broker Architecture, and that the measurement process and the modification software are located in separate remote computers that communicate over a network, as taught by Ellis, because, the combination would have eliminated the burden of requiring the user to be at the location of the device being tested through the measurement process, allowed the process to be monitored by experts located distant from the device under test, and, as suggested by Ellis, provided a method for correcting any

determined problems through remote diagnostics and repair (0008, lines 12-14) as well as allowed the device to be monitored by a team of users rather than just one user at the device itself (0023, lines 1-4).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

U.S. Patent Application Publication No. 2002/0016814 to Convent et al. teaches a method, system, and program for invoking stored procedures and accessing stored procedure data.

U.S. Patent Application Publication No. 2003/0055951 to Chemali teaches products, apparatus, and methods for handling computer software/hardware messages using Common Object Request Broker Architecture and Simple Object Access Protocol.

U.S. Patent Application Publication No. 2002/0184614 to Davia et al. teaches a method and computer program product for testing application program software.

U.S. Patent No. 6,216,237 to Klemm et al. teaches distributed indirect software instrumentation.

FOLDOC Free On-line Dictionary of Computing provides the definitions for "Common Object Request Broker Architecture", "Simple Object Access Protocol", and "ActiveX".

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. West whose telephone number is (703)308-1309. The examiner can normally be reached on Monday through Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (703)308-1677. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

jrw
September 7, 2003

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
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